

are a corrected set of new Figs. 1-15, grouped as Exhibit A, addressing the above noted typographical oversight.

Rejection Under 35 U.S.C. §103

Claims 1, 2, 4 and 11 were rejected under 35 U.S.C. §103 for obviousness predicated upon Shimizu et al. in view of Kawashima et al.

This rejection is traversed.

Specifically, submitted herewith as Exhibit B is a certified English language translation of the priority document. Pursuant to 35 U.S.C. §119, this application is entitled to the foreign priority date of July 24, 2000, which antecedes the November 28, 2000 issuance date of Kawashima et al. Accordingly, the reference to Kawashima et al. constitutes prior art by virtue of 35 U.S.C. §102(e). However, the subject matter disclosed by Kawashima et al. and the now claimed invention were, at the time the now claimed invention was made, owned by, or subject to an obligation of an assignment to, the same person, i.e., Mitsubishi Denki Kabushiki Kaisha. Accordingly, the reference to Kawashima et al. is not available for use in a rejection under 35 U.S.C. §103 by virtue of 35 U.S.C. §103(c).

Moreover, Applicant would again stress that the Examiner has not discharged initial burden of identifying a source in the applied prior art for each claim limitation as judicially required. *Smiths Industries Medical System v. Vital Signs Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). In this respect, Applicant would again invite the Examiner to favor the record by specifically identifying wherein either Shimizu et al. or

Kawashima et al. disclose or suggest a device wherein dummy trench isolation patterns comprise a trench patterning which constitutes a positioning mark extending in a second direction different from the first direction and connecting the dummy trench isolation pattern. In this respect, Applicant would note that layer 20a and Fig. 5 of Kawashima et al. is an impurity region; however, element 55 in Fig. 8 of Shimizu et al. is an oxide layer. It is not apparent and the Examiner has not identified wherein either of these elements constitutes a positioning mark or is capable of functioning as a positioning mark.

Conclusion

Based upon the foregoing, it should be apparent that the imposed rejection under 35 U.S.C. §103 is not viable since the reference to Kawashima et al. is not available for use of prior art under 35 U.S.C. §103 by virtue of 35 U.S.C. §103(c). Moreover, a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. §103 has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Applicant, therefore, submits that the imposed rejection of claims 1, 2, 4 and 11 under 35 U.S.C. §103 for obviousness predicated upon Shimizu et al. in view of Kawashima et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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